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Paper No. 12

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APR 15 1999

In re application of:
Scott Clare et al.
Application No. 09/083,422
Filed: May 5, 1998

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: **ON PETITION**
: **37 CFR §1.181**
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This is a decision on the Petition to the Commissioner filed November 4, 1998, under the provisions of 37 CFR §1.181.

Petitioner itemizes eight issues for review, and this decision will track petitioner's numbering for convenient reference. Each item as stated by petitioner is followed by the response.

1. *Must a declaration in each application specifically identify each parent, grandparent, great grandparent etc. ...*

The examiner requires in paragraphs 1-2 that a new declaration be filed. The examiner states that the declaration is defective because it "does not state that the person making the oath or declaration in a continuation-in-part application ... acknowledges the duty to disclose...". The examiner then goes on to state, however, that the declaration "[s]pecifically ... fails to also acknowledge the claim of priority ... with respect to ... 08/506,893."

The "duty to disclose" and the "claim of priority" are two separate issues. Regarding the former, 37 CFR §1.63(e) requires:

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which may name all, more, or fewer than all of the inventors named in the prior application. The oath or declaration in any continuation - in - part application must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation - in - part application.

The instant declaration includes the requisite averment, so the examiner's reference to the "duty to disclose" is inapposite. Therefore, with respect to this requirement the petition is **granted**.

Regarding the latter, the claim of priority, it is PTO practice that the specification and the declaration should be mutually consistent in their description of claims of priority. That is, if applications are listed in the specification as priority documents, they must also be in the declaration and vice-versa. Therefore, while the examiner cannot properly require a new declaration regardless of whether the priority claim is changed as in paragraphs 1-2 of the Office Action, to the extent the examiner requires the declaration and the specification to be consistent in their listing of priority applications, the examiner's position is consistent with PTO policy, and therefore nothing in this decision should be construed to preclude a continuation of the examiner's objection insofar as it may require consistency between the declaration and the specification in their identification of priority applications.

2. Must the identical component, when illustrated in two or more figures, be given a different reference numeral in each figure? ...

On this point, a review of the record does not reveal an instance where the examiner has clearly made such a requirement. The petition directs attention to Figures 9-12, which are said to "illustrate modification of the same storage box 103", and further alleges "the examiner has required that numerals 103 and 104 in Figures 10-12 each be renumbered differently"¹. These

¹ The petition does not point out where this requirement is made; it is assumed this item refers to ¶ 16 & 21 of Paper No. 9.

numerals are identified in the specification (e.g. page 15, line 7) as referring to a storage box and wheel well. The storage boxes and wheel well of Figures 10-12, however, are different "elements" in that they represent different embodiments of the box and of the well.

Therefore, with regard to this item, the petition is **dismissed**.

3. *Must each figure be separately identified by a separate paragraph in the Brief Description of the Drawings section of the application? ...*

The petition does not identify where the outstanding office action makes such a requirement, and it is not apparent from what action by the examiner petitioner here seeks relief. Consequently, with regard to this item, the petition is **dismissed**.

4. *Is the use of Figure 8A and Figure 8B improper? ...*

Since ¶ 23 of the outstanding action objects to the drawings as not having "been identified by the consecutive Arabic numerals 1 through 20", it is presumed petitioner here requests review of that requirement.

The examiner relies upon 37 CFR §1.84(u)(1) to support his position. This section states:

(u) Numbering of views.

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

The examiner further explains his reasoning on page 27 of the outstanding action, stating that "Figures 8A and 8B are not partial views intended to form one complete view ...", in apparent reference to the requirement that partial views must be designated by the same number followed by a capital letter.

This logic is flawed and the conclusion improper. If the first sentence of subsection (1) above were interpreted as excluding the possibility of views (partial or otherwise) designated as capital letters, the requirement of the second sentence would be in direct contradiction thereto. At the same time, the examiner appears to interpret the second sentence as its own converse, i.e. that if the views or partial views are not "intended to form one complete view", then the use of capital letters to designate such views is *prohibited*. This is not the case. The second sentence only says what it says, i.e. requires such partial views to be so designated, and is silent as to whether other views may not be so designated.

The first sentence of subsection (1) above requires the different views to be numbered in consecutive Arabic numerals. The instant application presents different views numbered with consecutive Arabic numerals. No numerals are skipped. The presence of alpha-enhanced numerals notwithstanding, the requirement of subsection (1) above is fully met.

Accordingly, with regard to the fourth item, the petition is **granted**.

5. *Is it proper for the examiner to refuse entry of proposed drawing corrections merely because all of the Examiner's objections were not overcome?*

For the purpose of this decision, this question is interpreted as a request to reverse the examiner's refusal to approve the proposed drawing correction filed September 21, 1998, since that proposal was disapproved in the outstanding action.

In Paper No. 6, the examiner objected to the drawings on multiple grounds. Applicant's response of September 21, 1998 included a proposed drawing correction (Paper No. 7). In Paper No. 9, the examiner based his refusal to approve the proposed correction on its alleged failure to comply with some of the grounds advanced. The examiner repeated all the original objections, apparently because of the non-entry of the proposed correction, without

commenting specifically on whether the proposed changes themselves would have overcome some of the objections.

In general, an examiner may disapprove proposed drawing corrections for a number of reasons, including the presence of new matter or other failures to comply with PTO policy. In circumstances where a proposed correction overcomes one or more but less than all grounds of objection, it is appropriate to consider, in addition to any insufficiencies in the proposal itself, whether approval of the proposal (presumably coupled with a continuation of the grounds of objection only insofar as they remain applicable) would advance the prosecution of the case. In the instant circumstances, petitioner's interest in entry of the proposed changes and narrowing of the issues appears consonant with advancing the prosecution. Although this assumes that there are no other reasons for non-entry of the proposed changes, the examiner has given none. Therefore, while this decision shall not be construed as final approval of the drawings in the application and shall not estop the examiner from raising proper objections consistent with this decision, with regard to the entry of the changes submitted May 18, 1998, the petition is **granted**.

6. *Is it proper for the Examiner to require submittal of "formal drawings" when no claim has been allowed? On page 17 of the 10/9/98 Office Action ...? ...*
7. *It is [sic] proper for the Examiner to require submittal of formal drawings because the instant application "is a continuation of [an] allowed application ...?... See page 28 of the Office Action...*
8. *On pages 17-19 of the Office Action ... Where no claims have been allowed, and where the proper numbering of figures and the numbering of the same component in different figures is in dispute, to require applicants to submit "New Formal Drawings" at this time is deemed to be improper and only serves to impose an*

unnecessary burden on Applicants. Is such a requirement proper?

Regarding issues 6-8, it is permissible for applicants to defer submission of formal drawings until allowance. Pursuant to MPEP §608.02:

Drawing corrections should be made when the application is in condition for allowance unless the examiner requires correction at an earlier date.

MPEP §608.02(b) states, *inter alia*:

In utility applications, the examination will normally be conducted using any informal drawings presented. The sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the informal drawings.

PTO policy draws a distinction between drawings requiring correction due to matters of content and matters of execution. Normally, when objecting to the drawings on the basis of content, the examiner may require that a *proposed* drawing correction be submitted at any time during regular prosecution on the merits to facilitate review of the proposal prior to allowance. Submission of formal drawings (proper in execution) actually incorporating such corrections may normally be deferred until allowance.

In the instant case, it is noted that the pending Office Action raises several grounds of objections to the drawings, some contested. The examiner contemporaneously holds the submitted proposals for correction insufficient and denies approval of the proposed corrections. Petitioner argues that if formal drawings had been submitted (or were to be submitted) they would appear to have been subject to disapproval on grounds of record. To require submission of formal drawings prior to approval of the proposed corrections would be pointless at best, and involve a futile expense at worst. There is no apparent benefit from having formal drawings required prior to establishing what their content should be, and as petitioner notes, it would impose an unnecessary burden on applicants.

Therefore, with respect to the deferral of the requirement to submit formal drawings until allowance of the application, the petition is **granted**.

If reconsideration on the merits of this petition or any aspect thereof is desired, a request therefor should be submitted promptly along with any pertinent documentation under a cover letter entitled "Renewed Petition to the Commissioner".

The petition filed November 4, 1998 was accompanied by a fee of \$130.00. Since no petition fee is required for the filing of a petition to the Commissioner requesting review of the requirements or objections made by an examiner, this petition fee will be refunded in due course.

Summary: Petition **granted-in-part** and **dismissed-in-part**.



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